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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,725	03/08/2007	Andreas Pein	101215-350	8226
27388	7590	04/11/2011	EXAMINER	
Hildebrand, Christa			MILES, JONATHAN WADE	
Norris McLaughlin & Marcus PA			ART UNIT	
875 Third Avenue, 8th Floor			PAPER NUMBER	
New York, NY 10022			3731	
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			04/11/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,725

Applicant(s)

PEIN, ANDREAS

Examiner

JONATHAN W. MILES

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3731

DETAILED ACTION

Response to Amendment

This office action is in response to the amendment filed February 4, 2011. Claim 8 is amended, and claims 8-14 are pending and addressed below.

Claim Rejections - 35 USC § 103

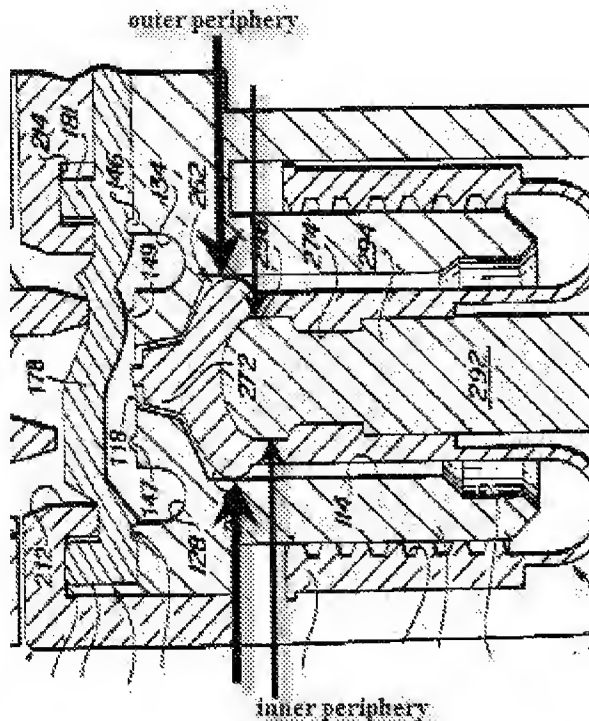
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 9, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoder et al. (US 5871462) in view of McDonnell et al. (US 591184) and Pelmulder et al. (US 4818190), hereinafter referred to as “Yoder,” “McDonnell,” and “Pelmulder” respectively. Yoder, McDonnell, and Pelmulder are cited in the previous office action.



**Image 1 from Pelmulder Fig.
113**

Regarding claims 8, 9, 11, and 14, Yoder discloses a water jet apparatus for severing a biological structure with a jet of severing liquid comprising water (col. 3, line 64), the water jet apparatus comprising: a storage container for the severing liquid (Fig. 1, [30]); a piston-cylinder unit comprising: a generally cylindrical opening is formed in a casing having a wall and a bottom (Fig. 2, [64]); a piston received in the cylindrical opening for reciprocal motion of the piston in cylindrical opening with space remaining adjacent to the bottom of the cylindrical opening (Fig. 2, [60]), the space functioning as a pressure space upon downstroke of the piston and a suction space upon upstroke of the piston (Fig. 3, [86]); a manipulable operating terminating in a jet (Fig. 1, [40]); a suction line for conducting the severing liquid from the storage container to the suction-pressure space in the cylinder (Fig. 1, [32]); a pressure line for conducting the severing

Art Unit: 3731

liquid from the suction-pressure space in the cylinder to the operating device (Fig. 1, [36]); and a coupling for attaching the eccentric drive to and detaching the eccentric drive from the piston (Fig. 2, [62]), the piston-cylinder unit together with the suction line, the pressure line, and the operating device constituting a sub-assembly, wherein the suction line is attachable to and detachable from the storage container and the cylinder casing by means of a first and second coupling and the pressure line is attachable and detachable from the manipulable operating device by a third coupling (see Fig. 1, col. 2, lines 59-61);

further comprising a protruding sealing lip formed on the cylinder (Fig. 2, [70];

but not opposite the bottom formed by the cylindrical opening, the cylindrical opening takes on a conical portion, or an annular membrane having an inner periphery and an outer periphery, the outer periphery attached to the conical portion of the generally cylindrical wall at a position in the upper zone of the piston-cylinder unit and an inner periphery attached to the piston at a position in the upper zone of the piston-cylinder unit, the upper zone defined by an annular space about the suction-pressured space, the membrane sealing interior of the piston-cylinder unit below the membrane from exposure to the ambient outside the piston-cylinder unit, and the membrane being dimensioned so as to allow reciprocation of the cylinder and the annular space being dimensioned so as to allow movement of the membrane therein as the piston reciprocates and to accommodate the membrane when the piston is at rest at the end of a downstroke; wherein at least a lowermost portion of the conical portion tapers inwardly in a downward direction toward the suction-pressured space; or a pressure tubule terminating in a jet; or wherein the suction pipe of the manipulable operating device is connected via an exhaust line to a pump.

Art Unit: 3731

However, Pelmulder discloses opposite the bottom formed by a cylindrical opening, the cylindrical opening takes on a conical portion (Fig. 113, the taper between bores 114 and 116); an annular membrane (Fig. 113, [266]) having an inner periphery and an outer periphery (see Image 1), the outer periphery attached to the conical portion of the generally cylindrical wall at a position in the upper zone of the piston-cylinder unit (see Fig. 113, wherein the outer periphery is attached to the outer wall of the conical portion when the piston is fully downstroked) and an inner periphery attached to the piston at a position in the upper zone of the piston-cylinder unit (see Fig. 113), the upper zone defined by an annular space about the suction-pressured space (see Fig. 113, wherein the suction-pressure space is opposite the upper zone in the area below the conical portion away from the piston and membrane), the membrane sealing interior of the piston-cylinder unit below the membrane from exposure to the ambient outside the piston-cylinder unit (see Fig. 113; col. 18, lines 29-35 discusses maintaining sterilization), and the membrane being dimensioned so as to allow reciprocation of the cylinder and the annular space being dimensioned so as to allow movement of the membrane therein as the piston reciprocates and to accommodate the membrane when the piston is at rest at the end of a downstroke (Figs. 113 and 114); wherein at least a lowermost portion of the conical portion tapers inwardly in a downward direction toward the suction-pressured space; or a pressure tubule terminating in a jet (see Fig. 113).

It would have been obvious to combine the membrane and conical portion taught by Pelmulder with the device of Yoder because it provides sterilization for the device (Pelmulder, col. 18, lines 29-35) and facilitates entry of the piston into the cylindrical opening (Pelmulder, col. 10, lines 14-17). The motivation for the modification would be to prevent bacteria from

Art Unit: 3731

building up in the device, and to ensure smooth entry of the piston to reduce the likelihood of malfunction.

Furthermore, McDonnell discloses a manipulable operating device (Fig. 1, [10]) including an internal pressure tubule terminating in the jet (Fig. 7, [36]) and a suction pipe sheathing the pressure tubule (Fig. 7, [100]), and wherein the suction pipe (Fig. 7, [66]) of the manipulable operating device is connected via an exhaust line to a pump (col. 6, lines 56-57).

It would have been obvious to combine the manipulable operating device of McDonnell et al. with the water jet apparatus of Yoder et al. because it allows for suction and jetting of water. The motivation for the modification would have been to remove excess fluid and emulsified tissue from the surgical site (McDonnell et al., col. 6, lines 67-69).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoder (US 5871462) in view of McDonnell (US 591184) and Pelmulder (US 4818190) as applied to claim 8 above, and further in view of Allen (US 3622251). Allen is cited in the previous action.

Regarding Claim 10, Yoder in view of McDonnell and Pelmulder discloses the water jet apparatus according to claim 8, but does not disclose the cylinder casing and the piston being constituted of plastic.

However, Allen discloses a cylinder casing and piston being constituted of plastic (col. 2, lines 69-71).

It would have been obvious to combine the plastic material of Allen with the piston and casing of claim 1 because plastic is more lightweight (Allen, col. 3, line 43). The motivation for the modification would be to make the apparatus more mobile.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoder (US 5871462) in view of McDonnell (US 591184) and Pelmulder (US 4818190) as applied to claim 8 above, and further in view of Rogers (US 4551146). Rogers is cited in the previous action.

Regarding Claim 12, Yoder in view of McDonnell and Pelmulder discloses the water jet apparatus according to claim 8, further comprising: a connecting device installed in the cylinder for connected the pressure tube to the suction-pressure space (see Fig. 3 where the pressure tube [36] connects to the cylinder [26] and a first opening through the cylinder casing (Fig. 3, [112]), and a connecting device comprising a pressure sleeve press fit into the first opening through the cylinder casing for effecting communication of the pressure line with the suction-pressure space (col. 4, lines 41-45) but does not disclose the connecting device comprising a pressure tubule concentrically received in the pressure sleeve and having external ribs spaced from an interior wall of the pressure sleeve by a distance corresponding to thickness of a wall of the pressure line, the wall of the pressure line at an end portion of the pressure line being gripped between the ribs of the pressure tubule and the interior wall of the sleeve.

However Rogers discloses a connecting device comprising a pressure sleeve (Fig. 3, [30]), a pressure tubule concentrically received in the pressure sleeve (Fig. 3, [18]) and having external ribs spaced from an interior wall of the pressure sleeve by a distance corresponding to thickness of a wall of the pressure line (Fig. 3, [20]), the wall of the pressure line at an end portion of the pressure line being gripped between the ribs of the pressure tubule and the interior wall of the sleeve (col. 3, lines 41-43; see Fig. 4).

Art Unit: 3731

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the pressure sleeve and the pressure tubule of Rogers with the water jet apparatus of claim 8 because it minimizes the possibility of a bacteria invasion (Rogers, col. 1, lines 59-60). The motivation for the modification would have been to disinfect the connection during its use (Rogers, col. 1, lines 12-13).

With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over the prior art which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Regarding claim 13, Yoder in view of McDonnell and Pelmulder, in further view of Rogers discloses the water jet apparatus according to claim 12, further comprising a second opening through the cylinder casing (Yoder et al., see Fig. 1 where the suction line [32] connects to the cylinder [26], see in more detail in Fig. 3), the second opening effecting communication of the suction line with the suction-pressure space (Yoder et al., col. 7, lines 39-41), but does not disclose the first and second openings being radially oriented and diametrically opposed with

Art Unit: 3731

respect to the cylinder whereby the connecting device is installable in the first opening by initial insertion thereof through the second opening.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the first and second openings radially oriented and diametrically opposed with respect to the cylinder, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Response to Arguments

Applicant's arguments filed February 4, 2011, have been fully considered but they are not persuasive. Applicant argues: (1) Yoder and Pelmulder are non-analogous art; and (2) the mechanisms of Pelmulder cannot be combined with the pump of Yoder, (3) nor is there a motivation to combine the mechanisms of Pelmulder with the pump of Yoder.

(1) In response to applicant's argument that Pelmulder is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Yoder discloses a fluid jet cutting device, wherein the fluid is driven by a pump. One of ordinary skill would naturally look to common pumping mechanisms for alterations and improvements to the pump of Yoder.

(2) First of all, Pelmulder is relied upon to be a teaching reference and not meant to be bodily incorporated. In response to applicant's argument that Pelmulder cannot be combined with Yoder, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed

Art Unit: 3731

invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, it appears the applicant believes the examiner is replacing the pump cartridge and its diaphragm 86 of Yoder with the member 266 of Pelmulder. However, this is not the case, the examiner is merely incorporating the generally cylindrical opening with the conical portion and the member attached to the casing and the piston as taught by Pelmulder to replace the purely cylindrical opening and piston without a membrane as disclosed by Yoder. The applicant implies that the combination would result in the working fluid contacting the membrane, but this is not that case, as the working fluid would only contact the diaphragm of the cartridge, which would be located below the conical portion. Also, the applicant does not claim that the working fluid does not come into contact with the membrane. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the working fluid does not come into contact with the membrane) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(3) The examiner has provided a motivation for combining the pump mechanisms of Pelmulder with the device of Yoder. Simply because applicant's actual invention does not require a membrane to ensure sterilization of the piston and cylindrical opening does not mean that the applicant's claimed invention clarifies the structure and arrangement that would obviate the motivation for adding the membrane of Pelmulder. In response to applicant's argument that

Art Unit: 3731

the applicant's device does not require a membrane to ensure sterilization, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Furthermore, in response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the claimed invention does not obviate the need for a membrane to ensure sterilization.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3731

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN W. MILES whose telephone number is (571)270-7777. The examiner can normally be reached on Monday-Thursday 7:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W. M./
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
4/8/11